

## REMARKS

Claims 11-20 are pending in the present application. Claim 11 has been amended in this response to improve form. No new matter has been introduced as a result of the amendment. Support for the present amendment can be found, for example, in the specification on page 3, last paragraph, and page 5, last paragraph.

Claims 11-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Mehrotra* (US Patent 6,115,717) in view of *Swanson et al.* (US Patent 5,987,459). Applicant traverses the rejection. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination does not teach “providing that said image sequence include predetermined individual objects that are respectively coded according to one of an MPEG standard and an ITU standard, said individual objects being at least one of audio objects and video objects” as recited in claim 11. As was argued previously, reliance upon *Mehrotra* as disclosing “predetermined individual objects that are respectively coded according to one of an MPEG standard and an ITU standard” in the context of “open space” is simply misplaced. *Mehrotra* clearly defines open space as the following:

A homogeneous and contiguous region of an image where text, captions or figurative elements can be placed without hiding any important image contents is called open space, or alternatively, copy space, dead space, negative or empty space. Images having these regions of regular, low contrast, relatively smooth texture qualities are desirable for the placement of such textual or figurative elements.

(col. 1, lines 22-26 – emphasis added). Furthermore:

Open space as used herein is defined as one or more completely bounded sub-regions of an image whose color and spatial properties appear visually uniform. Open space may or may not represent real world objects such as water, grass, or pavement.

(col. 3, lines 1-5). Accordingly, the open space disclosed in *Mehrotra* does not teach an “individual object”, but rather teaches a background (bounded sub-regions) where a lack of any text, captions or figurative elements exists in an image. In fact, the entire purpose of *Mehrotra* is directed to a system for the storage of a digital image in an image database, the system comprising: (a) a processor; (b) means for automatically generating with said processor open space metadata independent of manually inputting data; and (c) means for storing the open space metadata along with the associated image in the image database (col. 1, line 65 – col. 2, line 4). The disclosure also teaches indexing the *generated* (i.e., not predetermined) open space metadata as a precursor for subsequent searching (col. 2, lines 8-17). After a search is conducted, images are then mapped to determine the most appropriate image candidates for the open space (col. 4, lines 14-49). As the Examiner has already conceded, *Mehrotra* also fails to disclose objects being “respectively coded according to one of an MPEG standard and an ITU standard, said individual objects being at least one of audio objects and video objects.”

In light of this, the Office Action relies on *Swanson* in an attempt to combine the reference with *Mehrotra*. Applicant submits that the combination is improper, as there is no teaching, suggestion or motivation to combine the reference in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (MPEP 2143.01).

The Office Action has incorrectly equated “open space” to “individual objects” with regard to the *Mehrotra* reference discussed above. Surprisingly, the Office Action then asserts that the JPEG compression indexing disclosed in *Swanson* accounts for the deficiencies of *Mehrotra*. This is simply incorrect. *Mehrotra* already discloses digital image files (col. 3, lines

48-56 – which would presumably include JPEG images) that are mapped to the open spaces determined in the indexed searching (col. 4, lines 25-49). For what reason would one of ordinary skill in the art employ coding under either an MPEG or ITU standard to the open spaces disclosed in *Mehrotra*? The Examiner cannot have it both ways, claiming that “open space” means one thing for the purposes of implementing searching, and then claiming it means another thing for the purposes of establishing coding of the individual objects. Applicant has consistently maintained that an “individual object,” as part of a picture, refers to something which may be easily distinguished from the background of the picture. Conversely, “open space,” as part of the picture, cannot be distinguished from the background as it typically, in fact, actually defines the background. It is therefore respectfully submitted that the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

In light of the above, Applicant respectfully submits that independent claim 11 of the present application, as well as claims 12-20 which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this Application as a whole, the office is hereby authorized to deduct said fees from deposit account number 02-1818. If such a deduction is made, please indicate the Attorney Docket No. (0112740-408) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Peter Zura

Reg. No. 48,196

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4208

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